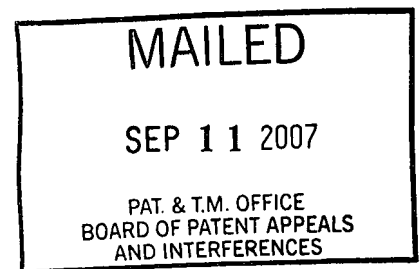1   RECORD OF ORAL HEARING
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3   UNITED STATES PATENT AND TRADEMARK OFFICE
4   _____
5
6   BEFORE THE BOARD OF PATENT APPEALS
7   AND INTERFERENCES
8   _____
9
10   Ex parte RONALD M. TANNER, MATTHEW E. LEWIS,
11   and NITU CHOUDHARY
12   _____
13

14   Appeal 2007-1986
15   Application 09/766,407
16   Technology Center 2100

17   _____
18
19   Oral Hearing Held: August 8, 2007
20   _____
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23 Before JOSEPH L. DIXON, HOWARD B. BLANKENSHIP, and
24 ST. JOHN COURTENAY III, Administrative Patent Judges
25
26 ON BEHALF OF THE APPELLANTS:
27
28   JAMES G. GATTO, ESQ.
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33
34
35   The above-entitled matter came on for hearing on Wednesday, August

36 8, 2007, commencing at 9:45 a.m., at the U.S. Patent and Trademark Office,

37 600 Dulany Street, Courtroom B, Alexandria, Virginia, before Jennifer M.

38 O'Connor, Notary Public.

1   JUDGE COURTENEY: Good morning. We'd like to welcome you

2   to the board. Have you been here before?

3   MR. GATTO: I have, yes. Good morning.

4   JUDGE COURTENEY: You have 20 minutes and if we ask you

5   questions we'll extend your time accordingly.

6   MR. GATTO: Okay, great. Thank you, very much. I'll try to be

7   brief, my comments. I think there's really one real key issue here upon

8   which the rejection could be overturned in its entirety, and that is the

9   examiner mistakenly confused the configuration data for what the term in

10 the claim that uses is an image.

11   JUDGE COURTENEY: Can you explain that in light of page one of

12 your specification, lines 14 through 17? The specification says an image, a

13 work station or other device that is detecting and recording information

14 related to memory, storage, processor applications, directory access

15 privileges and other features and resources representing the overall

16 configuration statement or device.

17   MR. GATTO: Right, that is part of what is referred to as image, but if

18 you look, for example, in the field of the invention, it specifically talks about

19 associating applications to an image, and in the part right below where you

20 quoted, it talks about having files in the image system as well.

21   Again, looking at the specs, perhaps we could have been clearer, but

22 when you look at the specification as a whole and the claims in particular,

23 you can see that the image is not just configuration data. Claim 1, for

24 example --

1   JUDGE COURTENEY: You're asking us to read in an application

2   into the word "image" when we broadly but reasonably construe the

3   language of your claim?

4   MR. GATTO: As far as interpreting the term "image," I think that in

5   light of the specification as a whole, it would include applications.

6   JUDGE COURTENEY: Are we allowed to read limitations from the

7   specification into the claims?

8   MR. GATTO: I'm not asking you to read limitations into the claim,

9   but it's a question of interpreting what the term "image" means as used in the

10   specification.

11   JUDGE DIXON: You define then the image to require that?

12   MR. GATTO: Yes. Some of the claims, for example, specifically

13   talk about having file sets in the image and those are some of the later claims

14   that we separately argued. You look at those, there's expressed support in

15   those claims for this issue. But I think the term "image" in general, it's well

16   know in New York --

17   JUDGE BLANKENSHIP: It seems like the broader claims wouldn't

18   require that then?

19   MR. GATTO: If you interpret the term "image" as it is used

20   throughout the specification consistently, it consistently talks about having

21   applications in the image. Right in the field of the invention, for example,

22   they associate applications with the base image.

23   The image is the set of information, the applications, the software, that

24   are on the machine that become the minimal set that you need to make it

25   work. The configuration data in Traversat is more analogous to what is

26   claimed as the hardware information. We use that configuration data to

1   determine, based on the rules, what software might be suitable to run on the

2   client device. But the image itself, I think it's clear from the specification as

3   a whole, it includes the software or the applications that are being run; it's

4   not just data.

5   JUDGE BLANKENSHIP: We're required to broadly but reasonably

6   construe your claim language in a manner that's consistent with the

7   specification, but we're not committed to read limitations from the

8   specification into the claims.

9   MR. GATTO: I agree.

10   JUDGE BLANKENSHIP: I don't see the word "application" in claim

11   1.

12   MR. GATTO: It's inherent in the definition of images, I guess is what

13   I'm saying. I realize there's two competing axioms. One is you can't read

14   limitations into the terms. The second is that you have to construe the terms

15   in light of the specification. I think it's in conjunction with construing how

16   image is used. It includes applications and software. That is part of the

17   concept of what's conveyed by the term "image" in the specification.

18   JUDGE DIXON: But you haven't defined that term specifically as

19   you're asserting, to have software, because the specification seems to say

20   that it could not have it in the background as generally used in the art, but

21   the way the rest of the specification, that you do use it, but then there's two

22   competing definitions. If the examiner uses one of the two, why isn't that

23   reasonable, unless you provide some extrinsic evidence, because it doesn't

24   sound like you have a specific intrinsic definition of the term?

1   MR. GATTO: I'm not sure it requires it be a definition. In

2   interpreting a claim element, you look at what the meaning is in light of the

3   specification as a whole. It doesn't have to be a specific definition.

4   JUDGE DIXON: But if there's a hole in the whole, I mean in the

5   background it seems to say that it doesn't necessarily have to be there. You

6   use the word "inherent," that it's inherent that it has—well, sort of now the

7   argument's contrary to how inherence usually goes. We are looking back at

8   you going well, there's one time when it doesn't necessarily have to be there,

9   and so you're saying necessarily like --

10   MR. GATTO: Just to be fair, I think that you're looking at one part.

11   If you look at the summary of the invention on page 2 for example, it talks

12   about the images downloaded, the service and the -- directory and

13   downloads with the image the set of files associated with the application

14   object.

15   Throughout the specification, if you look at the drawings as well, you

16   look through it, when it uses image it includes the applications in the

17   software. I agree that the part that you read, if you look at just that part, you

18   can say okay, that's all the image means. But the proper test is to look at the

19   specification as a whole to determine what a term means.

20   JUDGE DIXON: But if the examiner is looking at that one point in

21   the specification and says, well there's a situation where image does not have

22   to have it, it seems like that would be reasonable. We may disagree, but you

23   have the opportunity to clarify the claim at that point and then add a

24   limitation in, like you have in dependent claims, that go further to say, those

25   are in there. Then it's clear.

1   MR. GATTO: I understand what you're saying, but if we go back to

2   page 1 for a second, again, I think that this is not a definition of image. This

3   is saying you can image by detecting and recording information related to

4   memory, storage, processor --

5   JUDGE DIXON: What's the result of when you image something?

6   MR. GATTO: When you image it, when you download an image,

7   which is what this invention relates to, you're downloading the application

8   from the software. This says detecting. It's what's there. The memory, the

9   storage, the processor, that's the hardware information.

10   In claim 1 itself, it says detecting that hardware information and then

11 based on rules determining an image and downloading the image. The

12 language you refer to is not what defines an image. It's the hardware

13 information that you use to determine which image should be downloaded.

14   That's what I'm saying; that part is not the definition of an image.

15 When you look at how the term "image" is used consistently throughout the

16 specification, from the very first, from the field of the invention, it talks

17 about having applications associated with the image. There's applications

18 there; not just data.

19   I can understand how the examiner was confused by this, but I think

20 it's very clear, the claim itself recites hardware information, which is what

21 you referred to on page 1, and then the image. The term "image" in the

22 claim doesn't say application; I acknowledge that, in claim 1. But when you

23 look at what the word "image" means, you have to interpret it and in light of

24 the specification as a whole, the interpretation of the term "image"

25 consistently includes applications and software.

1   That's with respect to claim 1. I think that's one of the fundamental

2   differences. The second difference is that even if what Traversat discloses

3   as configuration data could be interpreted to be an image -- we don't think

4   it's correct, but we assume that—the way he goes about loading that

5   configuration data onto a machine is different than what is specifically

6   claimed.

7   He talks about overriding part of the configuration data that exists if

8   you want to update the groups or however, the categories he refers to of

9   configuration data. In the claimed invention, you have a base image. That's

10   kind of like the colonel, you can think of it as, and then you can add images

11   on to it. To an extent you're modifying; you have base image and you're

12   adding to it. You don't overwrite part of an image.

13   I think we make that point pretty clearly in the brief is that even if you

14   get over this fundamental issue of imaging configuration data, still the

15   invention is different with respect to what Traversat discloses and what's in

16   claim 1.

17   With respect to some of the later claims, I would submit that the

18   image, the issue --

19   JUDGE BLANKENSHIP: Let me stop you there. You're arguing

20   that the overwriting in the reference is not equivalent to the additional

21   images in claim 1?

22   MR. GATTO: Correct, because we have a base image. The base

23   image is like kind of the fundamental core. That's not going to change. You

24   can add to it, but you're not taking away part of the base image.   I

25   think part of the reason that Traversat can overwrite is because he's really

26   dealing with data and not images, not applications. It makes sense in the

1   context of data to overwrite part of the data. It doesn't make sense to

2   overwrite part of an application. I think that highlights again the

3   fundamental argument that we're making as to why he's dealing with

4   something different than we're dealing with.

5   JUDGE BLANKENSHIP: You're arguing the reference doesn't teach

6   this additional information; it's just replacing the information?

7   MR. GATTO: It's replacing part of it. There's not a base image to

8   begin with because if you overwrite part of it, it's a different image. You're

9   substituting images or replacing part, however you want to look at it, but you

10 don't have a base image to which you're adding.

11   The reason this is significant in an IT perspective is that the imaging

12 of a computer, a laptop or whatever it may be, you typically use a kind of

13 golden master disk, and if you have all these different configurations and

14 you want to store all these images, you have to create a lot of different

15 golden masters and that's referenced in the specification.

16   The problem with that is it's time consuming, it's inflexible, et cetera.

17 By using the approach that the invention does here, by having a kind of a

18 base image that's kind of common, and then you can pull these other

19 application objects to add to the image, it's a much more flexible system, and

20 much easier on the IT staff, which is stated throughout the specification.

21   JUDGE BLANKENSHIP: I would like to ask you a question about

22 the second from the last line of claim 1, where you have the language

23 wherein—actually, this is the third line from the end—wherein at least one

24 customized image comprises at least one image of the device and one or

25 more additional images. In particular that second to the last line when you

26 have the language, the at least one image of the device and the one or more

1 additional images, couldn't that be read broadly as a logical or between one

2 image of the device or one or more additional images, because you have at

3 least one modifier used in conjunction with the word "and" that's

4 interspersed between two elements in the claim?

5 MR. GATTO: I respectfully submit that I don't believe that would be

6 a proper interpretation. I think it's pretty clear there that the claim

7 requires—and again, this is consistent with the way it's described in the

8 specification—is that you have an image which is sometimes heard of as the

9 base image, and additional images, which are the initial applications you add

10 to that.

11 JUDGE BLANKENSHIP: But we have the responsibility of broadly

12 but reasonably construing your claim language in a manner consistent with

13 your specification. So you don't agree that that's an alternate construction of

14 your claim?

15 MR. GATTO: I don't. I think if the claim said or, that would be an

16 improper interpretation. I think that interpretation is replacing the word

17 "and" with "or."

18 JUDGE BLANKENSHIP: But you had the language, at least one of

19 element one and element two where element one would correspond to one

20 image of the device and element two would correspond to one or more

21 additional images?

22 MR. GATTO: It requires at least two images. Be at least one, which

23 could be one or more, and at least one other. It requires at least two images

24 to be part of what's imaged onto the device.

25 JUDGE BLANKENSHIP: That's your interpretation?

1   MR. GATTO: Correct. With respect to some of the additional claims

2   as I indicated, if you look, claim 6 for example, it specifically refers to the

3   creating a base image and then associating at least one image and one or

4   more additional images to the base image. That again I think takes it to a

5   further level of clarity with respect to the base image.

6   Claim 7 further recites that the images include file sets, which again,

7   those as referred to in the specification are file sets, are referred to as

8   application file sets. I think those claims and there's some corresponding

9   claims later on --

10   JUDGE BLANKENSHIP: Regarding the issue of file sets, even if we

11   assume arguendo that the reference doesn't explicitly and expressly disclose

12   a file per se, would you not agree that computer operating systems for

13   modern personal computers are structured around file systems?

14   MR. GATTO: I suppose that's true, but as used in the application the

15   word "file sets" is referring to application files. If you look, it refers to

16   application object. That's what's being referred to in the specification.

17   Again, it's a matter of interpretation. I believe that the proper interpretation

18   of file sets would include the applications.

19   JUDGE BLANKENSHIP: But again, looking at independent claim

20   27, I don't see the word "application" used in conjunction with files, or file

21   sets.

22   MR. GATTO: Twenty-seven? I'm sorry. Right, but it talks about file

23   sets being inserted into the image. Again, as that term is used in the

24   specification, I guess it gets back to the matter of interpretation again. I

25   understand the point you're making, that doesn't use the word "application"

26   specifically. But again, in construing what's indicated in the specification,

1   how it's being used, it's a matter of construing it as used consistently in the

2   specification, which is to refer to the applications.

3   I believe if you look at the examiner's rejection with respect to claim

4   27, he admits that the reference doesn't disclose file sets. This is a 102

5   rejection. You can't apply 103 type principles in this. I think that at a

6   minimum, claim 27, because the examiner admits that that's missing --

7   JUDGE BLANKENSHIP: Can you tell me why a file system or a file

8   per se would not be inherent in a modern computer system?

9   MR. GATTO: I don't think that's the relevant question. I think it

10   probably is, but even if it is, the reason I say it's not the relevant question is

11   that we're talking about having file sets in an image. I wouldn't say that

12   what Traversat discloses, which is configuration data, is not necessarily file

13   sets. The examiner acknowledges that. But I wouldn't disagree with you

14   that files and file systems in general are standard. But we're talking about

15   file sets that are inserted into an image, and those file sets refer to

16   application files. I think that's the distinction.

17   JUDGE BLANKENSHIP: But again, the word "application" is not

18   claimed; it's brought into the claims. I had one other question. On page 12

19   of your brief, you argue that the reference is silent with respect to augmented

20   configuration information. How do you juxtapose the word "augmented"

21   with the word "additional" that you have claimed; do they mean the same

22   thing to you?

23   MR. GATTO: Augmented, this is on page 12, you said? I'm trying to

24   find the reference. Where is that on the brief?

25   JUDGE BLANKENSHIP: Page 12 of the brief, fourth line from the

26   top of the page. Could not the word "augmented" read on something that's

1 different and not something that's merely additional to something that

2 already exists?

3   MR. GATTO: I believe augmenting clearly implies adding to, not

4 replacing. Unless you have any other questions, I think those were the—I'm

5 sorry, actually one last thing here. The claim 8, I think, you refer to some of

6 the other claims to not having as good a reputation of applications. Claim 8

7 does specifically talk about having application images, which makes it

8 expressly clear -- which we believe is inherent in the definition of images --

9 but at a minimum, claim 8 has the language that you believe was missing in

10 the other claims and I think which clearly distinguishes over this

11 configuration data of Traversat.

12   JUDGE BLANKENSHIP: When I looked at the specification for

13 contacts for this claim, application images, where would you point in the

14 specification for support?

15   MR. GATTO: I think throughout the specification there's support, but

16 if you look for example, as I mentioned in the field in the invention, it talks

17 about associating applications with images. It talks about that the image can

18 include application objects. Part of this is you'll store this. These are

19 reusable modules, which is implied with the object. The application image

20 would include an image that includes the application.

21   JUDGE BLANKENSHIP: But can you point me to a part of your

22 specification that discloses application images per se, that term?

23   MR. GATTO: I don't think that was an issue the examiner raised. I

24 apologize. I could look through it real quick. I think in the drawings, if I'm

25 not mistaken, it says application objects there. For example, in figure 6,

26 block 612, it's about creating an image for the application. I think it's not the

1   literal work, but that's the same concept; you have an application image,

2   which would be one example. Again, I think, as I said before, throughout

3   the specification, you have that the applications are associated with the

4   image. I think that what we're trying to convey in claim 8 at a minimum is

5   the same concept; we're just making it more clear that the image includes the

6   application.

7   JUDGE BLANKENSHIP: Okay. You're not required to absolutely

8   have literal support.

9   MR. GATTO: But I think that the concept is clearly there. I had no

10 other points unless you have any other questions?

11   JUDGE BLANKENSHIP: Thank you very much. Any other

12 questions?

13   MR. GATTO: Thank you, very much.

14   JUDGE DIXON: Thank you.

15   (Whereupon, at 10:04 a.m., the hearing was adjourned.)